IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	BALDUS, Heribert et al.
Serial No.	:	10/043,523
Confirmation No.	:	6224
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Group Art Unit	:	2623
Examiner	:	Clyde H. Jones III

APPEAL BRIEF
On Appeal from Group Art Unit 2623

Date: May 31, 2007

By: /s/ _____

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I. REAL PARTY IN INTEREST

The real party in interest is Koninklijke Philips Electronics N.V., the assignee of record.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any pending appeals, judicial proceedings, or interferences which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

a)   Claims 1-5 are pending. Claim 1 is independent.

b)   Claims 1-5 stand rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

The claims listed in section "VIII. Claims Appendix" of this Appeal Brief correspond to the claims as originally submitted with the filing of this application. No claim amendments have been submitted.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention, as recited in claim 1, is directed to a transponder with firmware (Fig. 2; page 3, lines 20-22) which firmware comprise several overlaid layers (Fig. 2, refs. 2, 12, 22; page 3, line 23 to page 4, line 11) containing several software components known as function modules (Fig. 2, refs. 3 to 11, 13 to 19; page 1, line 23 to page 2, line 3), where a bottom layer (Fig. 2; page 3, lines 23-33) contains the function modules (Fig. 2; refs. 3 to 11) which describe

the functionality of the hardware components of the transponder, and the function modules (Fig. 2, refs. 13 to 19) of the layer (Fig. 2, ref. 12; page 3, line 33 to page 4, line 11) lying above the bottom layer jointly form an application interface which can process an application software of various manufacturer-dependent central monitoring systems (page 2, lines 12-20), and hence the same transponder can be used in different monitoring systems with different protocols and management purposes (page 1, line 23 to page 2, line 24).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1 and 3 are properly rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,891,804 (hereinafter "Hargrove").

Whether claim 2 is properly rejected under 35 USC 103(a) as being unpatentable over Hargrove in view of U.S. Patent 6,041,051 (hereinafter "Doshi").

Whether claims 4 and 5 are properly rejected under 35 USC 103(a) as being unpatentable over Hargrove in view of U.S. Patent 6,976,163 (hereinafter "Hind").

VII. ARGUMENT

Appellant respectfully traverses the rejection in accordance with the detailed arguments set forth below.

A. Claims 1 and 3 are not properly rejected under 35 U.S.C. §102(e) as being anticipated by Hargrove.

1. Claim 1

In order for a reference to anticipate a claim the MPEP 2131 requires the reference to teach each and every element of that claim.

Appellant's claim 1 includes the features of: "the function modules (13 to 19) of the layer (12) lying above the bottom layer (2) jointly form an application interface which can process an application software of various manufacturer-dependent central monitoring systems."

In the final Office Action the Examiner points to Hargrove col. 2, lines 31-35 as describing the claimed feature. The Examiner argues that the presentation layer of Hargrove inherently provides the standard interface for heterogeneous systems. However, as described in col. 2, Hargrove's presentation layer contains functions that deal with transformation of data encodings, so heterogeneous systems may engage in communication. But Hargrove's described presentation layer functions do not form an application layer which can process an application software.

Appellant's claimed invention recites that the function modules form an application layer which can process an application software of various manufacturer-dependent central monitoring systems. In contrast, Hargrove is only describing transformation of data encodings so heterogeneous systems may engage in communication.

Furthermore, there is no description in Hargrove of an application software of various manufacturer-dependent central monitoring systems. In response, the Examiner further argues at the bottom of page 4 that an application/process that uses the application layer to interface to the physical layer to access hardware is a central monitoring system application. The Examiner again points to col. 2, lines 34-39 to support this assertion.

However, nowhere does Hargrove suggest that an application/process is monitoring information related to the hardware. Hargrove only states: "At the highest, or application, layer are protocols that support specific applications. An example of such an application is the transfer of files from one host to another." Appellant respectfully submits that transferring files among

hosts does not suggest an application/process which is monitoring any hardware, contrary to the assertions of the Examiner.

Hargrove is only describing that the highest layer is supporting specific applications and does not suggest various manufacturer-dependent central monitoring systems. Furthermore, there is nothing in the cited sections, or anywhere in the patent, concerning the application layer processing an application software. Thus, Appellant disagrees that Hargrove provides any suggestion that the function modules of the layer lying above the bottom layer jointly form an application interface which can process an application software of various manufacturer-dependent central monitoring systems as recited in claim 1.

In the "Response to Arguments" section of the final Office Action, the Examiner again states that an application layer can process central monitoring system application software inherently provided by different software manufacturers. The Examiner argues that a central monitoring system is any application/process that used the API to interface to the physical layer to access hardware. However, there is no support in Hargrove for this assertion by the Examiner, nor does the Examiner cite any section of Hargrove. The Examiner fails to provide any clarification only some indication that the Examiner believes the missing elements to be inherent. However, according to the MPEP 2163.07(a): "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

It is submitted that the missing descriptive matter is not necessarily present in Hargrove's functions in the presentation layer because Hargrove is completely silent on function modules at the application interface layer which can process an application software of various manufacturer-dependent central monitoring systems. Hargrove only discloses a function such as transformation of data encodings, at the presentation layer.

For at least the foregoing reasons it is respectfully submitted that Hargrove fails to show or teach, among other things, Appellant's claimed feature of the function modules of the layer lying above the bottom layer jointly form an application interface which can process application software of various manufacturer-dependent central monitoring systems, as recited in claim 1. Thus the rejection should be reversed.

2. Claim 3

Appellant's dependent claim 3 includes the features of: "the function modules (13 to 19) of the layer (12) lying over the bottom layer (2) are provided for access to the other function modules (3 to 11, 13 to 19) of the same layer and the bottom layer (2)."

In the final Office Action the Examiner points to Hargrove col. 2, lines 15-16. However, Hargrove describes that the layering provides a modularization of their implementations. Each layer is defined by the functions it relies upon from the next lower level and by the services it provides to the layer above it.

There is no description in Hargrove of the function modules of the layer lying over the bottom layer are provided for access to the other function modules of the same layer and the bottom layer.

Furthermore, claim 3 depends from claim 1 and includes all the limitations of claim 1. Accordingly, claim 3 is also allowable by virtue of at least the dependency and for the additional

subject matter recited therein which is not found in the cited reference. Thus the rejection should be reversed.

B. Claim 2 is not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Hargrove in view of Doshi.

Claim 2 depends from claim 1 and includes all the limitations of claim 1. The Examiner does not rely on Doshi to show the elements lacking in Hargrove with respect to the features found in independent claim 1. Accordingly, claim 2 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein and not shown in Doshi.

For at least the foregoing reasons, Appellant respectfully submits that claim 2 is not rendered obvious by the combination of Hargrove in view of Doshi and the rejection should be reversed.

C. Claims 4 and 5 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Hargrove in view of Hind.

1. Claim 4

Claim 4 depends from claim 1 and includes all the limitations of claim 1. Furthermore, claim 4 includes additional distinguishing features. For example, claim 4 recites: "the upper layer (22) is provided for access by a supplier of the central monitoring system and for the downloading of new application programs by the supplier of the central monitoring system…."

On page 6 of the final Office Action the Examiner points to Hargrove, col. 2, lines 34-39 and col. 4, lines 47-67 as showing this feature. However, Hargrove fails to teach the claimed features anywhere in the patent. Particularly the cited section do not suggest that the upper layer

is provided for access by a supplier of the central monitoring system. In addition, there is no suggestion that the upper layer is provided for the downloading of new application programs by the supplier of the central monitoring system.

Furthermore, the Examiner agrees that Hargrove fails to teach the recited feature of downloading function modules. The Examiner cites Hind where the downloading of firmware updates is described. However, claim 4 recites the bottom layer and the layer lying over the bottom layer are provided for access by the transponder manufacturer and for the downloading of function modules by the transponder manufacturer. Hind does not suggest that the bottom layer and the layer lying over the bottom layer are provided for the downloading of function modules.

In addition, Hind fails to cure the features lacking in Hargrove as described above with respect to independent claim 1. Accordingly, claim 4 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein and not shown in Hind. The combination of references fails to teach all the claimed features, therefore a prima facie case of obviousness has not be established and the rejection should be reversed.

2. Claim 5

Claim 5 depends from claim 4 and includes all the limitations of claims 1 and 4. The Examiner does not rely on Hind to cure deficiencies in Hargrove as described above with respect to independent claim 1. Accordingly, claim 5 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein and not shown in Hind.

For at least the foregoing reasons, Appellant respectfully submits that claim 5 is not rendered obvious by the combination of Hargrove in view of Hind and the rejection should be reversed.

CONCLUSION

In light of the above, Appellant respectfully submits that the rejection of claims 1-5 is in error, legally and factually, and must be reversed.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1.(original):   A transponder with firmware

- which firmware comprise several overlaid layers (2, 12, 22) containing several software components known as function modules (3 to 11, 13 to 19),

- where a bottom layer (2) contains the function modules (3 to 11) which describe the functionality of the hardware components of the transponder,

- and the function modules (13 to 19) of the layer (12) lying above the bottom layer (2) jointly form an application interface which can process an application software of various manufacturer-dependent central monitoring systems, and hence the same transponder can be used in different monitoring systems with different protocols and management purposes

2.(original): A transponder as claimed in claim 1, characterized in that a network element belonging to the transponder is a network element of a hybrid fiber coax (HFC) network.

3.(original): A transponder as claimed in claim 1, characterized in that the function modules (13 to 19) of the layer (12) lying over the bottom layer (2) are provided for access to the other function modules (3 to 11, 13 to 19) of the same layer and the bottom layer (2).

4.(original): A transponder as claimed in claim 3, characterized in that the upper layer (22) is provided for access by a supplier of the central monitoring system and for the downloading of new application programs by the supplier of the central monitoring system, and in that the bottom layer (2) and the layer (12) lying over the bottom layer (2) are provided for access by the

transponder manufacturer and for the downloading of function modules (3 to 11, 13 to 19) by the transponder manufacturer.

5.(original): A transponder as claimed in claim 4, characterized in that hardware (1) forming the basis of the transponder is intended for exchange while the layer (12) lying over the lower layer (2) and the upper layer (22) can remain unchanged.

IX. EVIDENCE APPENDIX

No evidence has been submitted pursuant to §§ **1.130, 1.131,** or **1.132** of this title nor any other evidence entered by the examiner and relied upon by appellant in the appeal.

X. RELATED PROCEEDINGS APPENDIX

Appellant is not aware of any appeals or interferences related to the present application.